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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,206	01/20/2004	Martin Konemann	247791US0	8069

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EXAMINER

GREEN, ANTHONY J

ART UNIT PAPER NUMBER

1755

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/759,206	Applicant(s) KONEMANN ET AL.	
	Examiner Anthony J. Green	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/24/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 9-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a composition comprising a perylene derivative, does not reasonably provide enablement for a compound comprising of a parent structure and at least one substituent covalently bonded to said structure. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

The entire specification is concerned with the production and use of a particular perylene derivative and accordingly this feature should appear in independent claims 9 and 13 as the specification does not appear to be enabled for all of the possible compounds which may be encompassed by instant claims 9 and 13. Applicant has not adequately described what the other compounds which may be encompassed by these claims and accordingly since the invention is concerned with a perylene derivative, this feature should appear in these claims.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the use of the terms “preferably” and “especially” renders the claim vague and indefinite because it is unclear whether the limitations following the terms are part of the claimed invention and the scope of the claim is unascertainable. See MPEP § 2173.05(d). The use of the phrase “if desired” renders the claim vague and indefinite. The phrase “the amine function” lacks proper antecedent basis.

In claim 4 the phrase “the electrostatically stabilizing radicals” lacks proper antecedent basis.

In claim 5 the use of the term “preferably” renders the claim vague and indefinite because it is unclear whether the limitations following the terms are part of the claimed invention and the scope of the claim is unascertainable. See MPEP § 2173.05(d). The phrases “the nitrogen atom” and “the carbon chain” appear to lack proper antecedent basis.

In claim 6 the use of the term “preferably” and the phrase “more preferably” renders the claim vague and indefinite because it is unclear whether the limitations following the term and phrase are part of the claimed invention and the scope of the claim is unascertainable. See MPEP § 2173.05(d).

In claim 7 the use of the term “especially” renders the claim vague and indefinite because it is unclear whether the limitations following the term is part of the claimed invention and the scope of the claim is unascertainable. See MPEP § 2173.05(d).

Claim 8 is confusing as written as it depends from 2 different claims each drawn to a different statutory category of invention. The phrase "obtainable by" is not a positive claim recitation.

In claim 9 it is unclear as to what exactly applicant is trying to claim. The use of the phrase "in particular" renders the claim vague and indefinite because it is unclear whether the limitations following the phrase is part of the claimed invention and the scope of the claim is unascertainable. See MPEP § 2173.05(d). The phrase "the substituent or substituents" appears to lack proper antecedent basis.

Claim 10 is confusing as written as it is unclear as to exactly what applicant is trying to claim as it depends from many different claims drawn to different statutory categories of invention.

In claim 11 the use of the term "preferably" and the phrase "more preferably" renders the claim vague and indefinite because it is unclear whether the limitations following the term and phrase are part of the claimed invention and the scope of the claim is unascertainable. See MPEP § 2173.05(d). The phrases "the sterically stabilizing radicals" and "the electrostatically stabilizing radicals" appear to lack proper antecedent basis.

In claim 12 the phrase "the pigments" lacks proper antecedent basis. The use of the term "preferably" and the phrase "more preferably" renders the claim vague and indefinite because it is unclear whether the limitations following the term and phrase are part of the claimed invention and the scope of the claim is unascertainable. See MPEP

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§ 2173.05(d). The limitation of “can be used for producing transparent colors” does not appear to be a positive claim limitation.

In claim 13 the use of the phrase “in particular” renders the claim vague and indefinite because it is unclear whether the limitations following the phrase is part of the claimed invention and the scope of the claim is unascertainable. See MPEP

§ 2173.05(d). The phrase “the substituent or substituents” appears to lack proper antecedent basis. The use of the phrase “at any desired point” renders the claim vague and indefinite. The phrase “the operation of preparing them” lacks proper antecedent basis and is vague and indefinite.

In claim 15 the phrase “the organic pigment” lacks proper antecedent basis.

In claims 16 and 17 use of the phrase “in particular” renders the claim vague and indefinite because it is unclear whether the limitations following the phrase is part of the claimed invention and the scope of the claim is unascertainable. See MPEP

§ 2173.05(d).

Claim Objections

5. Claims 8, 10 and 14 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim and also because multiple dependent claims must refer to other claims in the alternative only. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5 and 9-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Hetzenegger et al (US Patent No. 5,472,494).

The reference teaches pigment preparations comprising perylene derivatives as dispersants. See the abstract, the examples and the claims.

It is the position of the examiner that the formula of the reference encompasses that which is instantly claimed particularly when $Y=SO_3$ and $X=K^+$ in the structure of the reference. Accordingly the burden of proof is on the applicant to show that the instantly claimed formula differs from that of the reference.

Allowable Subject Matter

8. Claim 6 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

9. Claims 7-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and provided that any 112 rejections and/or objections are overcome.

Information Disclosure Statement

10. The Weber reference (US 6,409,816) has been considered however it is not seen to teach and/or fairly suggest the instant invention. The 2 cited foreign references were not initialed as copies were not provided.

References Cited In the Specification

11. Applicants should provide copies and any applicable translations or English language equivalents of the foreign references cited in applicant's specification on page 7 as it is unavailable to the examiner and considered pertinent to applicant's disclosure. Note that applicant is attempting to incorporating by reference this article and therefore it is required that a copy and translation be provided.

References Cited By The Examiner


12. The references are cited as showing the general state of the art and as such, they are not seen to teach or fairly suggest the instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
September 29, 2004